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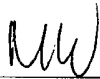
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,227	08/21/2000	Yuji Shimizu	028567/0103	7672
22850	7590	08/12/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER

3626

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/642,227	Applicant(s) SHIMIZU, YUJI	
	Examiner Rachel L. Porter	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) 58-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicants***

1. This communication is in response to the application filed 8/31/00 and the election filed 8/31/00. Claims 1-111 are pending. Claims 58-111 have been withdrawn from consideration as being drawn to non-elected invention.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Election/Restrictions***

3. Claims 58-111 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7 (filed 10/31/03).

### ***Claim Objections***

4. Claims 21-24 objected to because of the following informalities: the term "merchandise" is misspelled "merchanidize." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The previous 112, 2<sup>nd</sup> paragraph rejections have been addressed with amendments filed 5/21/04. However, new 112, 2<sup>nd</sup> paragraph issues have also been raised in the 5/21/04 response.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 30-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 30, it is unclear which steps are actively performed as a part of the Applicant's invention. In particular, the newly added language recites a "displaying step of displaying the merchandise...information received through the Internet, the displaying step further displaying an inquiry input screen for allowing the customers to input..." The instant claim later references an information-collecting step of collecting opinion information *inputted at the displaying step*. However, while the current claim language recites displaying an inquiry screen for allowing user input, it does not require or provide a positive recitation of a step of inputting opinion information into the inquiry screen. It is therefore unclear whether the step of *inputting* information into the displayed inquiry input screen is actually performed as a part of the Applicant's invention.

Furthermore, it is unclear to the Examiner which steps or elements of the recited method are performed via the Internet. For example, the claim recites "an opinion information collecting step of collecting the opinion information of the customers

inputted at the displaying step, through the Internet.” Again, it is unclear whether the applicant intends to claim that the display step occurs over the Internet, whether an implied inputting “step” is performed via the Internet, or whether both “steps” are Internet implemented. For the purposes of applying art, the Examiner has interpreted Internet-implementation in method(s)/system(s) in the prior art of record as addressing the newly added “through the Internet” limitations.

Claims 31-54 inherit the deficiencies of claim 30 through dependency, and are also rejected.

The analysis of claim 30 may also be applied to claims 55-57, which include similar limitations.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7, 29-33 and 55-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Abelow (USPN 5,999,908).

[claim 1] Abelow teaches a merchandise planning and development system comprising:

a merchandise planning information notice unit for informing many and unspecified customers of merchandise planning and development information relating to planning and/or development of new merchandise through the Internet; (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a display unit for displaying the merchandise planning and development information received from the merchandise notice unit through the Internet, the display unit further displaying an inquiry input screen for allowing the customers to input opinion information on the merchandise planning and development information (Figures 24-25, 30A, 33A, col. 69, lines 21-31; col. 85, lines 20-32—internet implementation)

an opinion information collecting unit for collecting the opinion information of customers inputted from the display unit information through the Internet; and (col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a merchandise information notice unit for informing the customers of information on merchandise designed according to an analysis of the opinion information through the Internet. (see abstract; col. 12, lines 20-col. 13, line 2; col. 16, lines 4-60; col. 18, lines 63-col. 20, lines 30; col. 69, lines 17-60; col. 85, lines 20-32) [claims 2-4] Abelow teaches a system for surveying the popularity of various products (i.e. plurality of products) at various stages of the product life cycle, including product launch (i.e. trial products) (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line

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33-col. 18, line 34; col. 18, lines 63-col. 19, lines 49, Figures 16, 22-24; col. 85, lines 20-32—internet implementation). Abelow further discloses that the system provides information on a plurality of new/prototype (i.e. trial) products (abstract, col. 19, line 42-col. 20, line 31—provides support and information on new development on product throughout product life cycle)

[claims 5-6] see Abelow: col. 10, lines 3-14; col. 75, lines 41-61.

[claim 7] Abelow teaches the merchandise planning and development system according to claim 1, wherein said opinion information collecting unit collects the opinion information from said many and unspecified customers, on the basis of the results of electronic inquiry in order to analyze the needs. (col. 27, line 65-col. 28, line 67; col. 35, line 64-col. 37, line 19)

[claims 29-30] The limitations of claims 29 and 30 are addressed by the rejection of claim 1.

[claims 31-33] Abelow teaches a method of surveying the popularity of various products at various stages of the product life cycle, including product launch (i.e. trial product) (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 18, lines 63-col. 19, lines 49, Figures 16, 22-24; col. 85, lines 20-32—internet implementation). Abelow further discloses that the system provides information on a plurality of new/prototype (i.e. trial) products. (abstract, col. 19, line 42-col. 20, line 31—provides support and information on new development on product throughout product life cycle)

[claim 55] Abelow teaches merchandise planning and development method comprising:

a merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to planning and/or development of a plurality of new merchandise on the basis of one concept through the Internet; (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a displaying step of displaying the merchandise planning and development information received through the Internet, the display step further displaying an inquiry input screen for allowing the customers to input opinion information on the merchandise planning and development information (Figures 24-25, 30A, 33A, col. 69, lines 21-31; col. 85, lines 20-32—internet implementation)

an opinion information collecting step of collecting opinion information of the customers inputted at the displaying step through the Internet; and (col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a merchandise information notice step of informing the customers of information on said plurality of new merchandise designed according to an analysis of the opinion information, through the Internet. (see abstract; col. 12, lines 20-col. 13, line 2; col. 16, lines 4-60; col. 18, lines 63-col. 19, lines 49; col. 69, lines 17-60; col. 85, lines 20-32)

[claims 56] Abelow teaches a computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform:



a merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to planning and/or development of new merchandise through the Internet; (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a displaying step of displaying the merchandise planning and development information received through the Internet, the display step further displaying an inquiry input screen for allowing the customers to input opinion information on the merchandise planning and development information (Figures 24-25, 30A, 33A, col. 69, lines 21-31; col. 85, lines 20-32—internet implementation)

an opinion information collecting step of collecting the opinion information of the customers inputted at the displaying step through the Internet; and(col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a merchandise information notice step of informing customers of information on merchandise designed according to an analysis of the opinion information through the Internet (see abstract; col. 12, lines 20-col. 13, line 2; col. 16, lines 4-60; col. 18, lines 63-col. 19, lines 49; col. 85, lines 20-32—internet implementation)

[claim 57] Abelow teaches a computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform:

a merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to

planning and/or development of a plurality of new merchandise on the basis of one concept through the Internet; (col. 9, lines 19-60; col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a displaying step of displaying the merchandise planning and development information received through the Internet, the display step further displaying an inquiry input screen for allowing the customers to input opinion information on the merchandise planning and development information (Figures 24-25, 30A, 33A, col. 69, lines 21-31; col. 85, lines 20-32—internet implementation)

an opinion information collecting step of collecting opinion information of the customers inputted at the displaying step, through the Internet; and (col. 16, lines 4-60; col. 17, line 33-col. 18, line 34; col. 85, lines 20-32—internet implementation)

a merchandise information notice step of informing the customers of information on said plurality of new merchandise designed according to an analysis of the opinion information, through the Internet. (col. 16, lines 4-60; col. 18, lines 63-col. 19, lines 49; col. 85, lines 20-32—internet implementation)

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-28 and 34-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelow (USPN 5,999,908) in view of Murcko, Jr. (USPN 6,578,014).

[claims 8-20] Abelow teaches the merchandise planning and development system that operates via the internet as explained in the rejection of claim 1, but does not expressly disclose that the system includes a sales booking unit and a price determining unit. However, Abelow does consider pricing information in determining which factors will improve product sales.(col. 87, lines 55-56). Murcko teaches a system further comprising:

a sales booking unit for accepting sales reservation of new merchandise to be released corresponding to the merchandise information from said many and unspecified customers through the Internet (Figure 17; col. 12, lines 2-27)

a selling price determining unit for determining the selling price of the new merchandise based on various market factors, including bidding and auction results (col. 28, lines 1-30)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Abelow with the teaching of Murcko to accept sales reservations and to allow for fluctuations in pricing depending upon various market conditions. One would have been motivated to include these features to ensure that the manufacturer of a particular product outperforms competitors. (Abelow: Figure 16)

[claims 21-24] Abelow teaches a system that allows the users to customize various product components. (col. 27, line 65-col. 28, line 67; col. 35, line 64-col. 37, line 19)

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Abelow further discloses a system that operates via the Internet and includes a display unit as explained in the rejections of claims 1 and 8. Abelow is silent as to whether the (customized component) display unit displays a reservation acceptance screen for allowing the customers to input information on reservations of new merchandise, as the amended claims currently recite. Murcko teaches a system that includes a customized display component, which displays a reservation acceptance screen and allows customers to input information on reservations of new merchandise. (Figures 17-18, col. 27, line 20-col. 28, line 36) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Abelow with the teaching Murcko to include a custom display unit that displays reservation acceptance information. As indicated by Murcko, one would have been motivated to include this feature to provide an electronic message that constitutes a statement of intent, which accurately reflects the customer's interests (col. 3, lines 16-39)

[claims 25-28] see Abelow: col. 55, line 58-col. 58, line 9. As per the recitation of Internet implementation in the amended claim language, see also Abelow: col. 85, lines 20-32.

[claims 34-46] Abelow teaches the merchandise planning and development method that operates via the internet as explained in the rejection of claim 30 above, but does not expressly disclose that the method includes a sales booking unit and a price determining unit. However, Abelow does consider pricing information in determining

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which factors will improve product sales.(col. 87, lines 55-56). Murcko teaches a merchandise planning and development method further comprising,

a sales booking step of accepting sales reservation of new merchandise to be released corresponding to the merchandise information from said many and unspecified customers though the Internet; and (Figure 17; col. 12, lines 2-27)

a selling price determining step of determining the selling price of the new merchandise based on various market factors, including bidding and auction results (col. 28, lines 1-30)

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Abelow with the teaching of Murcko to accept sales reservations and to allow for fluctuations in pricing depending upon various market conditions. One would have been motivated to include these features to ensure that the manufacturer of a particular product outperforms competitors. (Abelow: Figure 16)

[claims 47-50] Abelow teaches a system that allows the users to customize various product components. (col. 27, line 65-col. 28, line 67; col. 35, line 64-col. 37, line 19)

Abelow further discloses a system that operates via the Internet and includes a display unit as explained in the rejections of claims 30 and 34. Abelow is silent as to whether the (customized component) display unit displays a reservation acceptance screen for allowing the customers to input information on reservations of new merchandise, as the amended claims currently recite. Murcko teaches a system that includes a customized display component, which displays a reservation acceptance screen and

allows customers to input information on reservations of new merchandise. (Figures 17-18, col. 27, line 20-col. 28, line 36) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Abelow with the teaching Murcko to include a custom display unit that displays reservation acceptance information. As indicated by Murcko, one would have been motivated to include this feature to provide an electronic message that constitutes a statement of intent, which accurately reflects the customer's interests (col. 3, lines 16-39)

[claims 51-54] see Abelow: col. 55, line 58-col. 58, line 9. As per the recitation of Internet implementation in the amended claim language, see also Abelow: col. 85, lines 20-32.

### ***Response to Arguments***

12. Applicant's arguments filed 5/21/04 have been fully considered but they are not persuasive.

(A) On pages 38-40 of the response, the Applicant argues the newly added limitations of the current claim language. In particular, the Applicant argues that the prior art fails to disclose a system and method that operate via the Internet.

In response, the Examiner respectfully disagrees with the Applicant's interpretation of the prior art, and has provided specific citations in the Abelow reference (and the Murcko reference where as needed), which disclose Internet-implementation in the prior system and method. These new citations may be found in the art rejection

provided in the present Office Action and have been provided in response to the Applicant's amendments to the claims.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Biffar (USPN 6,397,212) discloses a system and method for learning consumer patterns and delivering information to users based upon those patterns.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

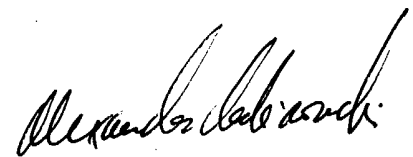
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP  
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**ALEXANDER KALINOWSKI**  
**PRIMARY EXAMINER**